

REMARKS

Claims 1 through 34 are currently pending in the application.

Claims 9 through 17 and 26 through 34 are withdrawn from consideration as being directed to a non-elected invention.

Claims 1 through 8 and 18 through 25 stand rejected.

This amendment is in response to the Final Office Action of April 7, 2003.

Claims 1 through 8 and 18 through 25 are objected to for informalities within the claims. Appropriate correction has been made.

Claims 1 through 4, 6 through 8, 18 through 21 and 23 through 25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sakemi et al. (U.S. Patent 5,655,704).

Claims 5 and 22 are rejected under 35 U.S.C. § 103(a) as being obvious over Sakemi et al. (U.S. Patent 5,655,704).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants submit that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants further submit that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

As presently amended independent claims 1 and 18 clearly set forth elements of the claimed invention calling for “a stencil plate a first pattern of a plurality of through-holes extending across said stencil plate”, “a stencil plate having a first pattern of a plurality of through-holes extending across said stencil plate”, and “a hopper extending across said upper surface of said stencil plate closely spaced therefrom to maintain control over all said spheres therein”. Applicants submit that the Sakemi et al. reference does not describe, either explicitly or inherently, such elements of the presently claimed invention either having a a plurality of holes extending across said stencil plate” or “a hopper extending across said upper surface of said stencil plate” }

In contrast to the elements of the presently claimed invention, the Sakemi et al. reference merely describes a hopper 12 which supplies solder balls across a portion of the stencil 4. Such is not the presently claimed invention. Therefore, the Sakemi et al. reference cannot and does not anticipate the presently claimed invention of amended independent claims 1 and 18.

Accordingly, presently amended independent claims 1 and 18 as well as the dependent claims therefrom are allowable.

Additionally, Applicants submit that regarding claims 5 and 22 rejected under 35 U.S.C. § 103 as being unpatentable over the Sakemi et al. reference such claims are clearly allowable as depending from allowable independent claims 1 and 18 respectively. Further, Applicants submit that the Sakemi et al. reference fails to teach or suggest the claim limitations of the presently claimed invention of independent claims 1 and 18 calling for “a stencil plate a first pattern of a plurality of through-holes extending across said stencil plate”, “a stencil plate having a first pattern of a plurality of through-holes extending across said stencil plate”, and “a hopper extending across said upper surface of said stencil plate closely spaced therefrom to maintain control over all said spheres therein”. Applicants submit that the Sakemi et al. reference does not describe, either explicitly or inherently, such elements of the presently claimed invention either having a a plurality of holes extending across said stencil plate” or “a hopper extending across said upper surface of said stencil plate” Therefore, the Sakemi et al. reference cannot and does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed inventions of claims 1 through 8 and

18 through 25 because it does not teach or suggest all the claim limitations of the claimed invention. Accordingly, claims 5 and 22 are allowable.

Applicants request entry of this amendment for the following reasons:

The amendment is timely filed.

The amendment clearly places the application in condition for allowance.

The amendment does not require any further search.

In summary, Applicants submit that claims 1 through 8 and 18 through 25 are clearly allowable over the cited prior art.

Applicants request the allowance of claims 1 through 8 and 18 through 25 and the case passed for issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James R. Duzan", followed by a large checkmark.

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